

REMARKS

Claims 1-5 and 43-80 were pending in the application. Claims 1, 3, 5, and 45-57 have been amended. Claims 45-57 have been amended to correct a typographical error. No claims have been added or cancelled. Claims 1-5 and 43-80 accordingly remain pending in the application subsequent entry of the present amendment.

Rejections Improperly Expressed and Not Complete

Prior to discussing the rejections, Applicant notes the nature of the present examination is entirely unhelpful and in no way facilitates prosecution of the present application. Of the 43 pending claims, only passing reference is made to the features of one claim (claim 1), and even there the claim features are not mentioned or discussed in any detail. Applicant submits the present examination is not in accord with the purposes of the rules related to compact prosecution (e.g., see MPEP 2106), omnibus type rejections (e.g., MPEP 707.07(b)), and completeness of actions (MPEP 707.07(d)). Note, for example, the guidance provided by MPEP 2106:

“It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.”

35 U.S.C. § 112 Rejections

Claims 67 and 68 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, in paragraph 4 of the present Office Action the examiner states:

“Claims 67 and 68 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67, line 2, "presentation slots" is not clear as to its meaning in juxtaposition with the specification and drawings.”

Applicant notes the examiner has provided no indication as to why the term is not clear on its face, or when considered in light of the specification and drawings. Applicant respectfully submits the term presentation slots is in accord with the specification and drawings, and one having ordinary skill in the art would have no difficulty ascertaining the meaning of the term. Should the examiner wish to maintain the rejections of claims 67 and 68, Applicant requests the examiner provide some explanation as to why the term is believed unclear in juxtaposition with the specification and drawings. For example, Applicant directs the examiner’s attention to MPEP 706.03(d) for guidance, and paragraph 7.34.01 in particular, which instructs:

¶ 7.34.01 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.11, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See MPEP §§ 2171 - 2174 for guidance. See also form paragraph 7.34.15 for pro se applicants.

In the present case, no explanation whatsoever has been offered as to why the term “presentation slots” is believed unclear. As noted above, Applicant believes the term to be clear and claims 67-68 are in compliance with 35 U.S.C. § 112. However, should the examiner wish to maintain the rejection, and provide a full explanation as to why the term is believed unclear, Applicant will then be in a position to further address such a rejection.

Hayashi Rejections

In paragraph 6 of the Office Action, claims 1-5 and 43-80 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,654,800 (hereinafter “Hayashi”). Applicant respectfully traverses these rejections and requests reconsideration in view of the following comments.

In the above rejections, the examiner states the following:

“Hayashi discloses, e.g. Fig. 3, an apparatus comprising a CPU 1, a digital switch, e.g. DS and automatically updating the unit price of an item. It is noted Applicant’s apparatus claim 1, and those depending therefrom, requires just means. Clearly, Hayashi comprises such. Official Notice is taken that an apparatus and means have been common knowledge in the advertisement art. Intended use claim language, e.g. for determining a price, are given little, if any, patentable subject matter in juxtaposition with positively recited claim language, e.g. an apparatus, means. To have executed the intended use claim

language with Hayashi would have been obvious to one of ordinary skill in the art.”

Applicant notes that claims 1-5 and 43-80 do not merely recite means and an intended use, as the Examiner suggests. Rather, numerous claim features are recited therein that include a structural difference over the cited art. For example, claim 1 recites means for automatically determining a price for a menu item. In contrast, Hayashi discloses a digital switch (DS) “for *manually* entering 4 digits from 0 to 9 so as to enter different Data” and “[a] new unit price is entered at the digital switch DS, and the set switch SS is depressed.” Further, Hayashi nowhere discloses or suggests anything regarding automatically determining a price for a menu item. Accordingly, Applicant submits there is no disclosure the apparatus of Hayashi is capable of performing the recited features, Applicant’s claims do not require just “means”, and the recited features require structural differences (e.g., via hardware and/or software) vis-à-vis the cited art. Neither is there any suggestion in Hayashi regarding automatically determining a price for a menu item. For at least these reasons, Applicant submits claim 1 is patentably distinguishable from the cited art and a prima facie case of obviousness has not been established in view of Hayashi and the Official Notice.

In addition to the above, claims 1-5 and 43-80, are rejected under 35 U.S.C. 103(a) as being unpatentable over [Hayashi] in view of Official Notice in paragraph 7 of the Office Action. In these rejections the examiner states:

“Applicant’s apparatus claim 1, and those depending therefrom, requires just means. Clearly, Hayashi comprises such. Official Notice is taken that an apparatus and means have been common knowledge in the advertisement art to implement intended use claim language. It is noted Applicant’s means may be no more than paper and pencil. The paper may be viewed as the storage device storing price information that is stored thereon. The processor may be a person’s hand using the pencil that generates information and crossing out old prices by dynamically entering new digital prices, the port may be nothing more than another piece of paper placed below the first piece of paper or some item adapted to receive the first piece of paper. This has been common knowledge in the digital menu art.”

Apart from the incongruity of stating that paper and pencil handwriting has been common knowledge in the *digital* menu art, Applicant respectfully submits the suggestion that Applicant's means may be no more than paper and pencil is in error. The law and the Rules (e.g., see MPEP 2181) require:

"A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function."

"If a claim limitation does include the phrase "means for" or "step for," that is, the first prong of the 3-prong analysis is met, but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase "means for" or "step for" is not being treated under 35 U.S.C. 112, sixth paragraph."

In the present case, Applicant submits claim 1 meets the above referenced 3-prong test and the examiner has not suggested otherwise as would be required by the Rules. Consequently,

"[T]he "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

Nowhere does Applicant's specification disclose the recited means may be pencil and paper. In view of the above, Applicant submits it is improper and incorrect for the examiner to

suggest “Applicant’s means may be no more than paper and pencil” and the rejections of paragraph 7 are in error for at least this reason.

In addition to the above, the examiner’s statements regarding “intended use” concerning many of the claims, including independent claim 43, are misplaced. Claim 43 recites a digital menu generating system, comprising:

- “a storage device storing price information, the price information comprising prices associated with a plurality of menu items;
- a processor coupled to the storage device, the processor being configured to:
 - generate information associated with a menu; and
 - dynamically update prices stored in said storage device based at least in part on revenue management information; and
- a port in communication with the processor, the port being adapted to output the information associated with the menu.”

The use of the phrase “configured to” in Applicant’s claims does not simply indicate intended use, as the Examiner apparently suggests. Applicant properly employs the phrase in describing the structure of various ones of the recited components. The “configured to” limitations in Applicants’ claims are functional limitations. The various instances of “configured to” in the claims accompany language that recites specific limitations of the corresponding element. In other words, the claims describe how the claim elements are actually configured to function, not merely an intended use. The use of functional limitations to define an invention has been expressly approved by the courts. *See, e.g., In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In fact, the Court has held that a functional claim limitation can distinguish over the prior art “because it set definite boundaries on the patent protection sought.” *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Moreover, the Court has held that limitations using “configured to” or “adapted to” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). As the examiner has not identified any disclosure of Hayashi equivalent to at least the recited “processor coupled to the storage device, the processor being configured to: generate information associated with a menu; and dynamically update prices stored in said

storage device based at least in part on revenue management information”, Applicant submits a prima facie case of obviousness has not been established for claim 43 for at least these further reasons.

Still further, Applicant submits it is readily apparent that there are numerous other claim features recited that require structural differences vis-à-vis the cited art and a prima facie case of obviousness has not been established in their regard. Representative examples are discussed below.

For example, claim 58 recites the further features:

“means for determining a time lag for updating menu information at a point-of-sale terminal after updating the menu displayed at the digital menu board; and after a period of time after updating the menu, means for automatically updating menu information at the point-of-sale terminal, the updated menu information at the point-of-sale terminal including the menu item and the price for the menu item, in which the period of time is not less than the determined time lag.”

Applicant submits the above recited features require structural differences vis-à-vis the cited art, and there is nothing in the cited art that discloses or suggests the above features, nor an ability to perform such functions.

Claim 60 recites the further features

“determining the time lag comprises: determining if a number of transactions being processed is not greater than a predetermined number of transactions; and performing one of: if the number of transactions being processed is not greater than the predetermined number of transactions, selecting a first time lag; and if the number of transactions being processed is greater than the predetermined number of transactions, selecting a second time lag.”

Applicant submits the above recited features require structural differences vis-à-vis the cited art, and there is nothing in the cited art that discloses or suggests the above features, nor an ability to perform such functions.

CONCLUSION

In light of the foregoing amendments and remarks, Applicants submit that all pending claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. If a phone interview would speed allowance of any pending claims, such is requested at the Examiner's convenience.

No fees are believed necessary; however, if any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzl, P.C. Deposit Account No. 50-1505/6124-00201/RDR.

Respectfully submitted,

/Rory D. Rankin/
Rory D. Rankin
Reg. No. 47,884
Attorney for Applicant(s)

MEYERTONS, HOOD, KIVLIN,
KOWERT & GOETZEL, P.C.
P. O. Box 398
AUSTIN, TEXAS 78767-0398
(512) 853-8800
Date: February 17, 2009